

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Michael E. Tasker

Confirmation No.: 5271

Serial No.: 09/583,695

Examiner: Shick C. Hom

Filed: May 31, 2000

Group Art Unit: 2616

For: PRIVATE BRANCH EXCHANGE (PBX) CONDITIONING
METHOD AND APPARATUS

Date: May 25, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

This review is requested for the reason(s) stated on the attached sheet(s). Note: no more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor
☐ assignee of record of the entire interest
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed)
☒ attorney or agent of record
☐ attorney or agent acting under 37 CFR 1.34

Total of 2 forms is submitted.

Customer No. 20575

Respectfully submitted,

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

The references do not teach an apparatus capable of transmitting signals to a PBX indicating an off-hook condition and removing the off-hook condition.

The independent claims are rejected as being unpatentable over Chang, et al., US Patent No. 6,700,956 in view of Holmquist, et al., US Patent No. 5,602,846. However, none of the references teach an apparatus capable of transmitting signals to a PBX indicating an off-hook condition and removing the off-hook condition.

Chang discloses an apparatus designed for a private user at the user's home that allows a user to use either Internet telephony or PSTN telephony to make calls and switch between them. See Chang col. 6, lines 35-44. The office action alleges that this apparatus is analogous to an

exchange system and then relies upon Holmquist to render the claims obvious by alleging that the exchange system is a PBX.

However, the use of a PBX gives rise to issues that do not occur and therefore are not addressed by Chang. In a PBX system, if a user wants to make a call outside the PBX, the PBX needs to be signaled that the phone is busy, or the PBX will continue to route calls to that phone. In Chang, the user has no need to signal another unit that the phone is busy. A private user makes all of the calls outside a PBX or a PBX-like apparatus and thus does not need to transmit any signals indicating the status of the phone.

The invention as claimed in claims 1, 10, 14 and 18, specifically requires that the off-hook signal be sent to the PBX. For example, claim 10 requires, “transmitting an off-hook indicator to the PBX that the PBX-connected telephone is temporarily incapable of receiving calls...” Claims 1, 14, and 18 include a similar limitation. When the users makes a call through the local PSTN in the claimed invention, the PBX does not ‘know’ that the phone is busy and must be explicitly signaled that it is busy. Chang does not need to send an explicit signal to indicate that the phone is off the hook, when the phone is off the hook it is automatically detected. See Chang col. 8, lines 57-62.

Further, in the claimed invention the off-hook indicator or signal informs the PBX that the PBX-connected telephone is ‘temporarily incapable of receiving calls.’ In Chang, the off-hook detector merely activates a subscriber line interface circuit (SLIC) to place one or the other calls. See Chang col. 8, lines 57-62. No signal needs to be actively transmitted to the SLIC, as the SLIC is connected to the phone jack (col. 5, lines 39-65), and thus, Chang does not teach such a signal.

Claim 1 also requires “transmitting a signal to remove the off-hook indicator from the PBX upon detection of termination.” The other independent claims, 10, 14 and 18, contain a similar limitation. In Chang, when the user hangs up, the SLIC is capable of detecting this hang up by itself. See Chang col. 9, lines 25-29. No active signal need be transmitted to remove the off-hook indicator as occurs in the claimed invention and Chang does not teach any such active signal.

Holmquist is merely cited for the proposition that an exchange server could be a PBX and thus does not cure the deficiencies of Chang with regard to transmission of the signals. Further, the claims recite many features not taught by Holmquist as evidenced by the ‘Reopen Prosecution’ disposition of the previous Pre-Appeal Conference in this case (dated 6 June 2006). It must be noted that the Reopen Prosecution disposition occurred after Applicants filed a request for pre-appeal conference based upon Holmquist in combination with a different reference (Brilla). That combination was not found to teach the invention as claimed.

Since neither Chang nor Holmquist teach all of the features recited in the independent claims, the combination of Chang and Holmquist does not render the claimed invention obvious.

The Examiner’s Response to Arguments does not fully respond to either the Applicant’s arguments for patentability or the claim features.

In the Response to Arguments section of the Final Office Action dated 26 February 2007, the Examiner asserts that the Applicant’s arguments are not persuasive because “Chang et al, in col. 5 line 66 to col. 6 line 12 recite when the telephone is off-hook that information is reported to the interface that controls the switch...” See Office Action dated 26 February 2007, page 2. However, the Applicant argued (similar to the arguments above) that Chang does not teach both

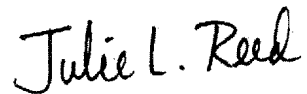
‘transmitting an off-hook indicator’ and ‘transmitting a signal to remove the off-hook indicator’. Even if Chang did teach what the Examiner proposes, this response only covers half of the argument. The Examiner has not indicated that Chang teaches ‘transmitting a signal to remove the off-hook indicator.’ As discussed above, Chang does not teach such a feature. The Applicant submits that had the Examiner fully considered the Applicant’s arguments in the previous Office Action, it would have been clear that the combination of Chang and Holmquist does not teach all of the claimed features.

The Applicant also asserts all arguments made previously, whether or not explicitly discussed herein, to preserve the right to assert these arguments in the Appeal Brief.

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Respectfully submitted,

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